

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

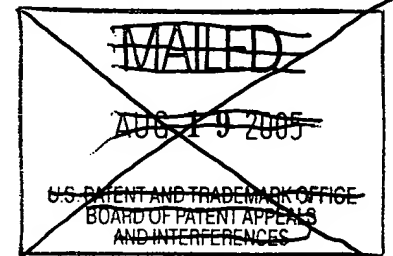
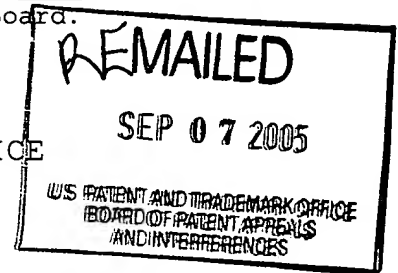
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WOLFGANG MAUS

Appeal No. 2005-1520
Application No. 09/632,248

ON BRIEF



Before WARREN, WALTZ and KRATZ, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-3, 6-15, 18, 19, 21 and 22, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a honeycomb element and an associated insulating mat and swelling mat and a catalytic exhaust gas purification device comprising such. An understanding of the invention can be derived from a reading of exemplary claims 1 and 12, which are reproduced below.

1. A catalytic exhaust-gas purification device, comprising:
 a casing;
 a monolithic ceramic honeycomb element mounted in said casing;
 a compensating layer disposed between said casing and said honeycomb element and wound around said honeycomb element, said compensating layer including:
 a swelling mat with border regions at risk from abrasion;
 an insulating mat having a border and an inner region;
 said border of said insulating mat having a thicker region at least at one end of said honeycomb element than at said inner region; and
 said swelling mat being disposed adjacent a side of said inner region of said insulating mat facing away from said honeycomb element and said thicker region of said border of said insulating mat covering said border regions of said swelling mat at risk from abrasion.

12. In combination with a honeycomb element, a compensating layer to be wound around the honeycomb element, comprising:
 an insulating mat with a border and an inner region, said inner region having a given thickness and said border of said insulating mat being thicker than said inner region at least in parts thereof; and
 a swelling mat with border regions at risk from abrasion, said swelling mat being disposed adjacent said inner region of said insulating mat with said thicker parts of said border covers said border regions of said swelling mat at risk from abrasion.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Santiago et al. (Santiago)	4,344,922	Aug. 17, 1982
Eyck	4,999,168	Mar. 12, 1991

Claims 1-3, 7, 8, 12-15 and 19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Locker.¹ Claims 6 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Locker in view of Eyck. Claims 9-11, 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Locker in view of Santiago and Eyck.

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The examiner has the initial burden of establishing a prima facie case of anticipation by pointing out where all of the claim limitations appear in a single reference. See In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990);

¹Also, Locker appears to be available as prior art under § 102(a).

In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138-39 (Fed. Cir. 1986). The reference must lead one of ordinary skill in the art to subject matter which falls within the scope of the claims "without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference" In re Arkley, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972).

All of the claims on appeal require a honeycomb element, an insulating mat and a swelling mat. The insulating mat includes an inner region that is not as thick, at least in part, than a thicker region located at a border region of the insulating mat. The border regions of the swelling mat are said to be at risk from abrasion and the swelling mat is disposed in a manner adjacent to the inner region of the insulating mat such that the thicker region of the insulating mat border covers "at risk" border regions of the swelling mat.

Appellant does not dispute the examiner's determination that Locker describes a catalytic converter with a honeycomb element and a swelling mat corresponding to appellant's claimed honeycomb element and swelling mat.

The examiner has taken the position that a barrier coating insulation layer (12) that has a thicker region (12A) corresponds

to the claimed insulation mat and is disposed in a relationship to the swelling mat (14) and honeycomb element (10) of Locker in a manner that is embraced by appellllant's appealed claims 1-3, 7, 8, 12-15 and 19. See, e.g., pages 3 and 4 of the answer and the portions of the specification and drawings of Locker referred to by the examiner.

However, appellant disagrees. In this regard, appellant asserts that the insulative coating layer (12) of Locker does not represent a "mat" as here claimed. See, e.g., pages 5-9 of the brief.

As our initial inquiry into a review of the examiner's anticipation rejection, we must analyze the claim language to determine the scope and meaning of such a contested limitation. See Gechter v. Davidson, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). During prosecution of a patent application, the terms in a claim are given their broadest reasonable interpretation consistent with the specification. In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984). Although no limitations in the specification is normally imputed to the claims being interpreted, see In re Paulsen, 30 F.3d at 1480, 31 USPQ2d at 1674, the specification can still be

used to impart the meaning of words in the claims, see In re Barr, 444 F.2d 588, 593, 170 USPQ 330, 335 (CCPA 1971).

A review of appellant's specification reveals that a definition for the contested insulating "mat" term is not furnished therein so as to give any special meaning to that term. At page 6 of the brief, appellant refers to a Merriam-Webster online dictionary (copy not attached to the brief) in maintaining that the contested "mat" term "generally means a piece of coarse, woven, plaited, or felted fabric." That definition of the term is consistent with one definition of mat found at page 716 of Merriam-Webster's Collegiate Dictionary, Tenth Edition.²

In some environments, as recognized by the examiner, a slab of reinforced concrete may constitute a mat.³ In this regard, we note that appellant's invention expressly encompasses an embodiment wherein the compensating layer can be assembled from preshaped segments (see appellant's drawing figures 3 -5 and appealed dependent claims 9-11). In our view, one of ordinary

² See definition 1 a (1) of mat at page 716 and the definition of fabric at page 415 of Merriam-Webster's Collegiate Dictionary, Tenth Edition (1996). A copy is attached to the decision.

³ See definition 3 of mat at page 716 of Merriam-Webster's Collegiate Dictionary, Tenth Edition (1996).

feature offered by the examiner in advancing the § 102(b) rejection discussed above.

Concerning this matter, we note that neither the examiner in the answer or appellant in the brief have addressed Locker's teachings about the alternative additives that can be used in an insulation coating. In this regard, Locker teaches that the insulation coating may comprise a selected additive material, including fiber additives. See column 4, lines 54-65 of Locker. We note that selecting the alternative of adding fibers to the insulation barrier coating of Locker as suggested therein would appear to have reasonably resulted in the formation of a mat layer; that is, a fiber containing layer surrounding the honeycomb structure of the catalyst. While picking and choosing from among numerous alternatives may have no place in making a § 102 rejection for anticipation, such can be entirely proper in making an obviousness rejection under § 103. See In re Arkley, 455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972).

Remand

In light of the above, we remand this application to the examiner for further consideration of the § 103(a) rejections and to determine whether or not a § 103(a) rejection of any of appellant's claims (including the independent claims) over Locker

skill in the art would have understand the term "mat" to require a material at least possessing some characteristics related to a "coarse, woven, plaited, or felted fabric." However, we agree with the examiner (answer, page 6) that the claim term mat includes within the scope thereof a rigid material.

Notwithstanding the breadth of that limitation, however, the examiner has not fairly explained how the insulative barrier coating of Locker that is described as being applied onto the honeycomb element by brushing (see column 6, lines 5-7) necessarily comprises a mat layer; that is a layer that includes felt, woven, plaited or coarse material characteristics or how such a brushed on layer is tantamount to a slab of reinforced concrete. On this record, we reverse the examiner's anticipation rejection.

§ 103(a) rejections.

Regarding the obviousness rejections that pertain to several of the dependent claims before us, we note that the examiner has not offered any further explanation as to how Locker alone or in combination with the other cited references may have reasonably suggested an insulation mat structure, as here claimed other than the broadly asserted anticipation analysis pertaining to that

with/without the other prior art of record is appropriate based on the suggestion in Locker of using added fibrous material in the barrier layer as an option and whether such optional additive material use would have reasonably been expected to result in a mat layer, as claimed. In this regard, we note that appellant acknowledges that an insulating mat typically includes known prior art "fiber mats" (specification, page 12, lines 8-13).

Pursuant to the provisions of 37 CFR § 41.50(a)(2) (effective Sept. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sept. 7, 2004)), appellant is required to timely respond to any supplemental examiner's answer that may be issued in response to this remand.

CONCLUSION

The decision of the examiner to reject claims 1-3, 7, 8, 12-14 and 19 under 35 U.S.C. § 102(e) as being anticipated by Locker is reversed as are the examiner's rejection under section 103(a). This decision includes a remand to the jurisdiction of the examiner for action consistent with our remarks set forth above pursuant to our authority under 37 CFR § 41.50(a)(1) (effective Sept. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sept. 7, 2004)).

REVERSED/REMANDED

PETER F. KRATZ
Administrative Patent Judge

PFK/sld

Appeal No. 2005-1520
Application No. 09/632,248

Page 11

LERNER AND GREENBERG, PA
P.O. BOX 2480
HOLLYWOOD, FL 33022-2480



Merriam- Webster's Collegiate[®] Dictionary

TENTH EDITION

Merriam-Webster, Incorporated
Springfield, Massachusetts, U.S.A.



A GENUINE MERRIAM-WEBSTER

The name *Webster* alone is no guarantee of excellence. It is used by a number of publishers and may serve mainly to mislead an unwary buyer.

Merriam-Webster™ is the name you should look for when you consider the purchase of dictionaries or other fine reference books. It carries the reputation of a company that has been publishing since 1831 and is your assurance of quality and authority.

Copyright © 1996 by Merriam-Webster, Incorporated

Philippines Copyright 1996 by Merriam-Webster, Incorporated

Library of Congress Cataloging in Publication Data
Main entry under title:

Merriam-Webster's collegiate dictionary. — 10th ed.

p. cm.

Includes index.

ISBN 0-87779-708-0 (unindexed : alk. paper). — ISBN 0-87779-709-9 (indexed : alk. paper). — ISBN 0-87779-710-2 (deluxe : alk. paper). — ISBN 0-87779-707-2 (laminated cover).

1. English language—Dictionaries. I. Merriam-Webster, Inc.

PE1628.M36 1996

423—dc20

95-36076

CIP

Merriam-Webster's Collegiate® Dictionary, Tenth Edition principal copyright 1993

COLLEGIATE is a registered trademark of Merriam-Webster, Incorporated

All rights reserved. No part of this book covered by the copyrights hereon may be reproduced or copied in any form or by any means—graphic, electronic, or mechanical, including photocopying, taping, or information storage and retrieval systems—without written permission of the publisher.

Made in the United States of America

1516RMcn96

BEST AVAILABLE COPY

masterly intended to replace it, has continued in reputable use all along; it cannot rationally be called an error.

master gunnery sergeant *n* (1958) : a noncommissioned officer in the marine corps ranking above a master sergeant

master key *n* (1576) : a key designed to open several different locks

masterly \mas-tər-lē/ *adj* (15c) : suitable to or resembling that of a master; esp : indicating thorough knowledge or superior skill and power (a ~ performance) **usage** see MASTERFUL — mas-ter-li-ness *n* — **masterly** *adv*

mas-ter-mind \mas-tər-mind, mas-tər-ˈ/ *n* (1720) : a person who supplies the directing or creative intelligence for a project

mastermind *vt* (1940) : to be the mastermind of

master of arts *often cap M&A* (15c) 1 : the recipient of a master's degree that usu. signifies that the recipient has passed an integrated course of study in one or more of the humanities and sometimes has completed a thesis involving research or a creative project and that typically requires two years of work beyond a bachelor's degree 2 : the degree making one a master of arts — abbr. M.A., A.M.

master of ceremonies (1662) 1 : a person who determines the forms to be observed on a public occasion 2 : a person who acts as host at a formal event 3 : a person who acts as host for a program of entertainment (as on television)

master of science *often cap M&S* (ca. 1905) 1 : the recipient of a master's degree that usu. signifies that the recipient has passed an integrated course of study in one or more of the sciences and sometimes has completed a thesis involving research and that typically requires two years of work beyond a bachelor's degree 2 : the degree making one a master of science — abbr. M.S., M.Sc.

mas-ter-piece \mas-tər-pēs/ *n* (1605) 1 : a work done with extraordinary skill; esp : a supreme intellectual or artistic achievement 2 : a piece of work presented to a medieval guild as evidence of qualification for the rank of master

master plan *n* (ca. 1930) : a plan giving overall guidance

master race *n* (1937) : a people held to be racially preeminent and hence fitted to rule or enslave other peoples

master's *n* (1939) : a master's degree

master sergeant *n* (ca. 1934) : a noncommissioned officer ranking in the army above a sergeant first class and below a staff sergeant major, in the air force above a technical sergeant and below a senior master sergeant, and in the marine corps above a gunnery sergeant and below a master gunnery sergeant

mas-ter-singer \mas-tər-sin-ər/ *n* (1810) : MEISTERSINGER

mas-ter-stroke \-strōk/ *n* (1679) : a masterly performance or move

mas-ter-work \-wɜrk/ *n* (1617) : MASTERPIECE

mas-tery \mas-t(ə)-rē/ *n* [ME *maistrerie*, fr. OF, fr. *maistre* master] (13c) 1 : the authority of a master : DOMINION b : the upper hand in a contest or competition : SUPERIORITY, ASCENDANCY 2 a : possession or display of great skill or technique b : skill or knowledge that makes one master of a subject : COMMAND

mas-ter-head \mas-tər-hed/ *n* (1748) 1 : the top of a mast 2 a : the printed matter in a newspaper or periodical that gives the title and pertinent details of ownership, advertising rates, and subscription rates b : the name of a publication (as a newspaper) displayed on the top of the first page

mas-tic \mas-tik/ *n* [ME *mastik*, fr. L *mastiche*, fr. Gk *masticē*, prob. back-formation fr. *mastician*] (14c) 1 : an aromatic resinous exudate from mastic trees used chiefly in varnishes 2 : any of various pasty materials used as protective coatings or cements

mas-tic-cate \mas-tə-kāt/ *vb* -cat-ed; -cat-ing [LL *masticatus*, pp. of *masticare*, fr. Gk *mastican* to gnash the teeth; akin to Gk *masasthai* to chew — more at MANDIBLE] *vt* (1649) 1 : to grind or crush (food) with or as if with the teeth in preparation for swallowing : CHEW 2 : to soften or reduce to pulp by crushing or kneading ~ *vi* : CHEW — **mas-tic-ca-tion** \mas-tə-kā-shən/ *n* — **mas-tic-ca-tor** \mas-tə-kā-tər/ *n*

mas-tic-ca-to-ry \mas-ti-kə-tōr-ē, -tōr-ē/ *adj* (1694) 1 : used for or adapted to chewing (~ limbs of an arthropod) 2 : of, relating to, or involving the organs of mastication (~ paralysis)

masticatory *n*, *pl* -ries (ca. 1611) : a substance chewed to increase saliva

mastic tree *n* (15c) : a small southern European evergreen tree (*Pistacia lentiscus*) of the cashew family that yields mastic

mas-tiff \mas-taf/ *n* [ME *mastif*, modif. of MF *mastin*, fr. (assumed) VL *mansuetinus*, fr. L *mansuetus* tame — more at MANSUETUDE] (14c) : any of a breed of very large massive powerful smooth-coated dogs that are apricot, fawn, or brindle and are often used as guard dogs

mas-tig-o-ph-o-ran \mas-tə-gā-fə-rən/ *n* [ultim. fr Gk *mastig-*, *mastix* whip + *pherein* to carry — more at BEAR] (ca. 1911) : any of a subphylum (Mastigophora) of protozoans comprising forms with flagella and including many often treated as algae — **mastigophoran** *adj*

mas-ti-tis \ma-sti-təs/ *n*, *pl* -ti-ti-des \-sti-tə-dēz/ [NL, fr. Gk *mastos* breast] (ca. 1842) : inflammation of the breast or udder usu. caused by infection — **mas-ti-tic** \-sti-tik/ *adj*

mas-to-don \mas-tə-dān, -dən/ *n* [NL *mas-todon*, *mastodon*, fr. Gk *mastos* + *odont-*, *odon-*, *odont* tooth — more at TOOTH] (1813) 1 : any of numerous extinct mammals (genus *Mastodon* syn. *Mammui*) that differ from the related mammoths and existing elephants chiefly in the form of the molar teeth 2 : one that is unusually large — **mas-to-don-ic** \mas-tə-dā-nik/ *adj* — **mas-to-dont** \mas-tə-dānt/ *adj* or *n*

mas-toid \mas-tōid/ *adj* [NL *mastoides* resembling a nipple, mastoid, fr. Gk *mastoeidēs*, fr. *mastos* breast] (1732) 1 : being the process of the temporal bone behind the ear; also : being any of several bony elements that occupy a similar position in the skull of lower vertebrates 2 : of, relating to, or occurring in the region of the mastoid process

mastoid *n* (1842) : a mastoid bone or process

mastoid cell *n* (1800) : one of the small cavities in the mastoid process that develop after birth and are filled with air

mas-toid-ec-to-my \mas-tōi-dek-tə-mē/ *n*, *pl* -mies [ISV] (1898) : surgical removal of part of the mastoid process of the temporal bone

mas-toid-itis \mas-tōi-di-təs/ *n* [NL] (ca. 1890) : inflammation of the mastoid and esp. of the mastoid cells

mas-tur-bate \mas-tər-bāt/ *vb* -bat-ed; -bat-ing [L *masturbatus*, pp. of *masturbare*] *vi* (1857) : to practice masturbation on ~ *vi* : to practice masturbation — **mas-tur-ba-tor** \-bā-tər/ *n*

mas-tur-ba-tion \mas-tər-bā-shən/ *n* (1766) : erotic stimulation esp. of one's own genital organs commonly resulting in orgasm and achieved by manual or other bodily contact exclusive of sexual intercourse, by instrumental manipulation, occas. by sexual fantasies, or by various combinations of these agencies

mas-tur-ba-to-ry \mas-tər-bə-tōr-ē, -tōr-ē/ *adj* (1864) 1 : of, relating to, or involving masturbation (~ fantasies) 2 : excessively self-absorbed or self-indulgent (write tedious, ~ books... about themselves for people to read... with envy — D. R. Katz)

mat \mat/ *n* [ME, fr. OE *meatte*, fr. LL *matia*, of Sem origin; akin to Heb *mittāh* bed] (bef. 12c) 1 a (1) : a piece of coarse, woven, plaited, or felted fabric used esp. as a floor covering or a support (2) : a piece of material placed at a door for wiping soiled shoe soles b : a decorative piece of material used under a small item (as a dish) esp. for support or protection c : a large thick pad or cushion used as a surface for wrestling, tumbling, and gymnastics 2 : something made up of densely tangled or adhering strands esp. of organic matter (algal ~) (a ~ of unkempt hair) 3 : a large slab usu. of reinforced concrete used as the supporting base of a building

mat *vb* **mat-ted**; **mat-ting** *vi* (1549) 1 : to provide with a mat or matting 2 a : to form into a tangled mass b : to pack down so as to form a dense mass ~ *vi* : to become matted

mat \mat/ *vt* **mat-ted**; **mat-ting** (1602) 1 : to make (as a metal, glass, or color) matte 2 : to provide (a picture) with a mat

mat *var* of MATTE

mat *n* [F *mat* dull color, unpolished surface, fr. *mat*, *adj.* — more at MATTE] (1845) : a border going around a picture between picture and frame or serving as the frame

mat *n* (1904) : MATRIX 2a

mat-a-dor \ma-tə-dōr/ *n* [Sp, fr. *matar* to kill] (1681) : a bullfighter who has the principal role and who kills the bull in a bullfight

match \mach/ *n* [ME *macche*, fr. OE *gemæcca* mate, equal; akin to OE *macian* to make — more at MAKE] (bef. 12c) 1 a : a person or thing equal or similar to another b : one able to cope with another c : an exact counterpart 2 : a pair suitably associated (carpet and curtains are a ~) 3 a : a contest between two or more parties (a golf ~) (a soccer ~) (a shouting ~) b : a contest (as in tennis or volleyball) completed when one player or side wins a specified number of sets or games 4 a : a marriage union b : a prospective partner in marriage

match *vi* (14c) 1 a : to encounter successfully as an antagonist b (1) : to set in competition or opposition (2) : to provide with a worthy competitor c : to set in comparison 2 : to join or give in marriage 3 a (1) : to put in a set possessing equal or harmonizing attributes (2) : to cause to correspond : SUIT b (1) : to be the counterpart of; also : to compare favorably with (2) : to harmonize with c : to provide with a counterpart d : to provide funds complementary to 4 : to fit together or make suitable for fitting together 5 a : to flip or toss (coins) and compare exposed faces b : to toss coins with ~ *vi* : to be a counterpart — **match-able** \ma-cha-bəl/ *adj* — **match-er** *n*

match *n* [ME *macche*, fr. MF *meiche*] (1549) 1 : a chemically prepared wick or cord formerly used in firing firearms or powder 2 : a short slender piece of flammable material (as wood) tipped with a combustible mixture that bursts into flame when slightly heated through friction (as by being scratched against a rough surface)

match-board \mach-bōrd, -bōrd/ *n* (ca. 1858) : a board with a groove cut along one edge and a tongue along the other so as to fit snugly with the edges of similarly cut boards

match-book \-būk/ *n* (1944) : a small folder containing rows of paper matches

match-box \-bāks/ *n* (1786) : a box for matches

match-less \-ləs/ *adj* (ca. 1530) : having no equal : PEERLESS — **match-less-ly** *adv*

match-lock \-jāk/ *n* (1637) 1 : a slow-burning match lowered over a hole in the breech of a musket to ignite the charge 2 : a musket equipped with a matchlock

match-mak-er \-mā-kər/ *n* (ca. 1639) : one that arranges a match; esp : one who tries to bring two unmarried individuals together in an attempt to promote a marriage — **match-mak-ing** \-kɪŋ/ *n*

match play *n* (1893) : golf competition in which the winner is the person or team winning the greater number of holes — compare STROKE PLAY

match point *n* (1921) : a situation (as in tennis) in which one player or side will win the match by winning the next point; also : the point itself

match-stick \mach-stik/ *n* (1791) 1 : a slender piece esp. of wood from which a match is made 2 : something resembling a matchstick esp. in slenderness

match-up \-p/ *n* (1964) : MATCH

match-wood \-wūd/ *n* (1838) : small pieces of wood : SPLINTERS

mate \mat/ *vi* **mat-ed**; **mat-ing** [ME, fr. MF *mater*, fr. OF *mat*, *n.* — checkmate, fr. Ar *māt* (in *shāh māt*)] (14c) : CHECKMATE 2

mate *n* (14c) : CHECKMATE 1

mate *n* [ME, prob. fr. MLG *māt*; akin to OE *gemetta* guest at one's table, *mete* food — more at MEAT] (14c) 1 a (1) : ASSOCIATE, COMPANION (2) chiefly Brit : an assistant to a more skilled worker : HELPER (3) chiefly Brit : FRIEND, BUDDY — often used as a familiar form of address b archaic : MATCH, PEER 2 : a deck officer on a merchant ship ranking below the captain 3 : one of a pair; as a : either member of a couple and esp. a married couple b : either member of a breeding pair of animals c : either of two matched objects

mate *vb* **mat-ed**; **mat-ing** *vi* (1509) 1 archaic : EQUAL MATCH 2 : to join or fit together : COUPLE 3 a : to join together as mates b : to provide a mate for ~ *vi* 1 : to become mated (ears that ~ well) 2 : COULATE

ma-té or **ma-te** \mä-tā/ *n* [F & AmerSp; F *maté*, fr. AmerSp *maté* vessel for drinking it, fr. Quechua *mati* vessel] (1758) 1 : a tea-like beverage drunk esp. in So. America 2 : a So. American shrub or tree (*Ilex paraguariensis*) of the holly family whose leaves and shoots are used in making maté; also : these leaves and shoots



mastiff

BEST AVAILABLE COPY

